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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,597	01/05/2001	Prodromos Pericles Stephanos	STEP-00-001	4758

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22

EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Appli ation No.

09/756,597

Applicant(s)

STEPHANOS, PRODRAMOS
PERICIES

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 14, 2003 has been entered.
2. This Office action is in response to the remarks and declaration filed on March 14, 2003.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins (5,252,107) in view of Wesley (5,773,706).

Wilkins teaches a lighter fluid composition comprising from about 15 to about 30 weight % of a terpene, from about 40 to about 70% of an alcohol, from about 10 to about 30 weight % water and from about 1 to 2% surfactant (see col. 3, lines 41-63). Wilkins teaches the limitations of the of the claims other than the differences that are discussed below.

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In the first aspect, Wilkins differs from the claim in that he does not specifically teach that the lighter fluid contains a thickener. However, Wesley teaches that cross-linked polyacrylic acid thickening agents are used to thicken fuels, such as charcoal lighter fluid (see col. 1, lines 21-30; col. 6, lines 13-48).

It would have been obvious to one of ordinary skill in the art to have added a thickener to the lighter fluid of Wilkins because Wesley teaches that the cross-linked polymers of his invention are added to alcoholic base lighter fluids, such as those taught by Wilkins in order to reduce the rate of evaporation of the fluid.

In the second aspect, Wilkins differs from the claims in that he does not teach that the alcohol is methanol or ethanol. However, this difference is not deemed to be unobvious because Wilkins teaches homologues of the claimed alcohols. Therefore, it would be reasonable to expect that given the close structural similarity of the compounds that the claimed compounds and those of Wilkins would possess similar properties. See MPEP 2144.09.

In the third aspect, Wilkins differs from the claims in that he does not specifically teach that the composition contains aliphatic hydrocarbons. However, it would have been obvious to one of ordinary skill in the art to have included aliphatic hydrocarbons because the terpene compounds may be aliphatic and to combine two components known to be used for the same purpose is *prima facie* obvious.

4. Applicant's arguments filed have been fully considered but they are not persuasive.

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Applicant argues that the prior art does not suggest the claimed invention because there is no suggestion to gel and emulsify the terpene-based lighter fluid.

Wilkins teaches or suggests all of the claimed components with the exception of the thickening agent. Wilkins teaches that the composition of his invention has reduced volatile organic compound emissions upon ignition. The composition of Wilkins also has a pleasant smell since it too contains terpenes. Wesley teaches that gelling agents are used to thicken charcoal lighter fluid. Wesley teaches that the gelled fluid has a significantly reduced rate of evaporation and due to this decreased rate of evaporation the effectiveness of the fluid is increased. The prior art clearly teaches what Applicant is claiming and had the same goals as applicant.

Wesley clearly recognized that the reduced evaporation would equate to a longer burn time since he states that the decreased rate of evaporation increased the effectiveness of the fluid.

With respect to Wilkins teaching a single phase product, the composition initially is an emulsion, but becomes clear upon standing for several hours. However, upon addition of a thickening agent, the composition would develop an emulsion-type appearance.

5. Applicant's declaration has been considered but is not deemed to be persuasive.

The licensing of a product does not equate to commercial success, not does the distribution of that product to over 22 retail chains. Evidence of licensing is a secondary consideration because licensing programs may succeed for reasons unrelated to the unobviousness of the product. Duraflame is one of the market leaders in hearth and

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barbeque accessories and the consumer's recognition of this name may have attributed to the number of units sold.

Gross sales figures do not show commercial success absent evidence as to the market share, or as to the time period during which the product was sold, or as to what sales would normally be expected in the market.

Wilkins satisfied the long-felt need of producing a charcoal lighter fluid that has reduced VOCs. Therefore, Applicant's invention does not satisfy a long-felt need which was recognized, persistent, and not solved by others.

Applicant's commercial product is not commensurate in scope with the claimed invention. Printed on the front label of the container is the language "with natural orange oil". There are no claims directed to natural orange oil. The claims contain a terpene or a citrus-derived terpene. While orange oil contains d-limonene, it is not made up of 100% d-limonene. In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not to unclaimed features.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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872-9310 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Cephia D. Toomer
Examiner
Art Unit 1714

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May 1, 2003

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